UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/585,669	06/01/2000	Thomas Moran	673-1005	4523

23644   7590   06/19/2009

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EXAMINER
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ART UNIT	PAPER NUMBER
2416	

NOTIFICATION DATE	DELIVERY MODE
06/19/2009	ELECTRONIC

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte THOMAS MORAN

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Appeal 2009-000,986
Application 09/585,669
Technology Center 2400

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Decided:[1] June 17, 2009

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Before ROBERT E. NAPPI, MARC S. HOFF and
CARLA M. KRIVAK, *Administrative Patent Judges.*

NAPPI, *Administrative Patent Judge.*

DECISION ON APPEAL

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[1] The two-month time period for filing an appeal or commencing a civil action, as recited in 37 CFR § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

This is a decision on appeal under 35 U.S.C. § 134(a) of the final rejection of claims 35-65.[2] We have jurisdiction under 35 U.S.C. § 6(b).

We affirm-in-part the Examiner's rejection of these claims.

INVENTION

The invention is directed to a conference system wherein a user is able to view, select, and invite participants to participate in a subconference through the use of a graphical interface. *See* Spec. 1-14. Claim 35 is representative of the invention and reproduced below:

> 35. A method of conferencing comprising the steps of:
> forming a main conference between a plurality of users,
> presenting at least one of said users in the main conference with a graphical list of the main conference participants,
> providing said user with an interface to interact with said graphical list of main conference participants, such that said user has an option to request a subconference with a subset of other users by selecting subconference participants from said graphical list using said interface,
> forming a subconference between said user and the subset of other users,
> maintaining private from the main conference at least some communication between the subset of users in the subconference during the subsistence of the subconference, and
> presenting to said user a graphical list of the subset of users in the subconference, when the subconference is in progress.

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[2] Appellant cancelled claims 2, 5-6, 21-23, 28, and 31 in an Amendment filed 6 January 2004. Appellant cancelled claim 4 in an Amendment filed 16 November 2004. Appellant cancelled claims 1, 3, 7-20, 24-27, 29-30, and 32-24 and added claims 35-65 in an Amendment filed 9 August 2005.

REFERENCES

Theimer	US 5,812,865	Sep. 22, 1998
Beyda	US 6,404,873 B1	Jun. 11, 2002 (filed Dec. 1, 1998)
Hamilton	US 6,757,259 B1	Jun. 29, 2004 (filed Aug. 12, 1999)

REJECTIONS AT ISSUE

The Examiner rejected claims 35-51, 58, and 60-65 under 35 U.S.C. § 103(a) as being unpatentable over Beyda. Ans. 3-10.

The Examiner rejected claims 52-55, 57, and 59 under 35 U.S.C. § 103(a) as being unpatentable over Beyda in view of Hamilton. Ans. 10-11.

The Examiner rejected claim 56 under 35 U.S.C. § 103(a) as being unpatentable over Beyda in view of Hamilton and Theimer. Ans. 12.

ISSUES

Rejection of claims 35-51, 58, and 60-65 under 35 U.S.C. § 103(a) as being unpatentable over Beyda

Claims 35, 51, 60, and 62

Appellant argues on pages 11-14 of the Appeal Brief and pages 2-3 of the Reply Brief that the Examiner's rejection of claims 35, 51, 60, and 62 is in error. Appellant argues that Beyda does not teach "presenting a list of main conference participants to one of the users in the main conference." App. Br. 12. Appellant also argues that Beyda does not teach using an interface to select a subconference participant. App. Br. 14. Finally, Appellant argues that Beyda does not teach presenting a list of

subconference participants when the subconference is in progress. App. Br. 15. Thus, with respect to claims 35, 51, 60, and 62 Appellant's contention presents us with three issues. (1) Has Appellant shown that the Examiner erred in finding that Beyda teaches presenting a list of main conference participants to one of the users in the main conference? (2) Has Appellant shown that the Examiner erred in finding that Beyda teaches using an interface to select a subconference participant? (3) Has Appellant shown that the Examiner erred in finding that Beyda teaches presenting a list of subconference participants when the subconference is in progress?

Claims 37-41, 43-50, 61, and 63-65

Appellant does not specifically address the rejection of claims 37-41, 43-50, 61, or 63-65, which are subject to the same rejection as independent claims 35, 60, and 62, which are addressed in the Appeal Brief. Therefore, we select claims 35, 60, and 62 to be representative of claims 37-41, 43-50, 61, and 63-65, which depend upon claims 35, 60, and 62. Thus, Appellant's contentions with respect to the rejections of claims 37-41, 43-50, 61, and 63-65 present us with the same issues as discussed above with respect to the rejection of claims 35, 60, and 62.

Claim 36

Appellant argues on page 16 of the Appeal Brief that the Examiner's rejection of claim 36 is in error. Appellant argues that Beyda does not teach a subconference wherein the participants are entirely isolated from participating in the main conference. Thus, with respect to claim 36, Appellant's contention presents the issue: has Appellant shown that the Examiner erred in finding that Beyda teaches a subconference wherein the users are entirely isolated from participation in the main conference?

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Claims 42 and 58

Appellant argues on page 16 of the Appeal Brief that the Examiner's rejection of claims 42 and 58 is in error. Appellant argues that Beyda does not teach providing a subconference list to the users in the main conference during the subsistence of the subconference. Thus, with respect to claims 42 and 58, Appellant's contention presents the issue: has Appellant shown that the Examiner erred in finding that Beyda teaches providing a subconference list to the users in the main conference during the subsistence of the subconference?

Rejection of claims 52-55, 57, and 59 under 35 U.S.C. § 103(a) as being unpatentable over Beyda in view of Hamilton

Claims 52-55, 57, and 59

Appellant argues on page 17 of the Appeal Brief that claims 52-55, 57, and 59 are allowable based upon their dependency on claim 51. Thus, Appellant's arguments with respect to the Examiner's rejection of claims 52-55, 57, and 59 present the same issue as claim 51.

Rejection of claim 56 under 35 U.S.C. § 103(a) as being unpatentable over Beyda in view of Hamilton and Mier

Claim 56

Appellant argues on page 17 of the Appeal Brief that claim 56 is allowable based upon its dependency on claim 51. Thus, Appellant's arguments with respect to the Examiner's rejection of claim 56 present the same issue as claim 51.

FINDINGS OF FACT (FF)

Beyda

1. Beyda teaches a telecommunications system and method of establishing and managing a main conference call and subconference call. Col. 1, ll. 5-8.

2. Telephone operators set up and control conference calls by selectively adding and dropping individuals from a conference call. Visual displays are maintained by an operator that lists a name and telephone number for each of the conference call participants. Col. 1, ll. 32-36.

3. Beyda also discloses a conference management system in which a party from one conference combines with a second conference that is already in progress. Col. 1, ll. 47-51.

4. The coordinating party has the ability to connect and disconnect parties from the first conference with the second conference and then subsequently reconnect the parties, thereby creating subconferences. Col. 1, ll. 51-59.

5. In order to assist with the connection and disconnection of parties, the coordinator's computer terminal displays names and telephone numbers of all the parties involved in the conference. Col. 1, l. 66 through col. 2, l. 2.

6. Beyda teaches that in the prior art to establish subconferences, parties wishing to be involved in the subconference must first be disconnected from the main conference call. When this occurs, other coordinators are able to detect that parties have been dropped. Col. 2, ll. 1-9.

7. To overcome the deficiency found in the prior art, Beyda also teaches the ability to listen to the main conference while participating in a subconference and the ability to rejoin the main conference. Col. 2, ll. 9-13 and col. 7, ll. 1-5.

PRINCIPLES OF LAW

Office personnel must rely on Appellants' disclosure to properly determine the meaning of the terms used in the claims. *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 980 (Fed. Cir. 1995) (en banc). "[I]nterpreting what is *meant* by a word *in* a claim is not to be confused with adding an extraneous limitation appearing in the specification, which is improper." *In re Cruciferous Sprout Litigation,* 301 F.3d 1343, 1348 (Fed. Cir. 2002) (internal quotation marks and citations omitted; emphasis in original).

On the issue of obviousness, the Supreme Court has stated that "[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 416 (2007).

> When a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, § 103 likely bars its patentability. For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill. . . . [A] court must ask whether the improvement is more than the predictable

use of prior art elements according to their established
functions.

Id. at 417. "One of the ways in which a patent's subject matter can be
proved obvious is by noting that there existed at the time of the invention a
known problem for which there was an obvious solution encompassed by the
patent's claims." *Id.* at 419-420.

It is well settled that when a claimed product reasonably appears to be
substantially the same as a product disclosed in the prior art, the burden of
proof is shifted to applicant to prove that the prior art product does not
inherently or necessarily possess the characteristics attributed to the claimed
product. *In re Spada*, 911 F.2d 705, 708-709 (Fed. Cir. 1990); *In re Best*,
562 F.2d 1252, 1255 (CCPA 1977). "Whether the rejection is based on
'inherency' under 35 U.S.C. § 102, on 'prima face obviousness' under 35
U.S.C. § 103, jointly or alternatively, the burden of proof is the same, and its
fairness is evidenced by the PTO's inability to manufacture products or to
obtain and compare prior art products." *Best*, 562 F.2d at 1255 (CCPA
1977).

The Examiner bears the initial burden of presenting a prima facie case
of obviousness, and Appellant has the burden of presenting a rebuttal to the
prima facie case. *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992).
Appellant has the burden, on appeal to the Board, to demonstrate error in the
Examiner's position. *See In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir.
2006).

ANALYSIS

Rejection of claims 35-51, 58, and 60-65 under 35 U.S.C. § 103(a) as being unpatentable over Beyda

Claims 35, 51, 60, and 62

Appellant's contentions have not persuaded us that the Examiner's rejection of claims 35, 51, 60, and 62 is in error. Independent claim 35 recites "presenting at least one of said users in the main conference with a graphical list of the main conference participants, providing said user with an interface to interact with said graphical list of main conference participants, such that said user has an option to request a subconference with a subset of other users by selecting subconference participants from said graphical list using said interface," and "presenting to said user a graphical list of the subset of users in the subconference, when the subconference is in progress." Appellant's Specification does not specifically define the term "user." Therefore, we find the term "user" to be any person who accesses or uses the conferencing system. Thus, the scope of claim 35 includes a telephone operator or any party to the conference system. In addition, Appellant's Specification does not specifically define the term "graphical list." Therefore, we find the term "graphical list" to be a visual list of participants involved in a conference call, whether it is the main conference call or a subconference call. Thus, the scope of the claim includes a visual display. Independent claims 51, 60, and 62 recite similar limitations.

First, Appellant argues that it is not inherent that Beyda teaches presenting a graphical list of participants to one of the users in the main conference because it is possible to establish a conference without a

graphical interface. App. Br. 12; Reply Br. 2. While we agree with Appellant's reasoning, we are not persuaded of Examiner error, as we find that the use of graphical lists is disclosed in Beyda.

Beyda teaches a telecommunications system and method of establishing and managing a main conference call and subconference calls. FF 1. Telephone operators can set up and control conference calls by selectively adding and dropping individuals from a conference call. FF 2. In order to do this, a visual display is maintained by the operator that lists a name and telephone number for each of the individuals involved in the conference call. FF 2. The operator is considered to be a user of the system. Since the operator maintains a visual display of individuals in the conference call, Beyda does teach presenting a graphical list of the main conference participants to at least one of the users in the main conference.

Second, Appellant argues that Beyda does not teach the use of a graphical list to select subconference participants because sending a request from one terminal to another does not require a user to select a participant from a graphical list. App. Br. 14; Reply Br. 3-4. However, Beyda teaches a system in which a party from one conference combines with a second conference. FF 3. The coordinating party has the ability to connect and disconnect parties from the first conference with the second conference and then subsequently reconnect the parties. FF 4. The act of connecting and disconnecting parties from the conference to a separate conference constitutes the selection of the participants for a subconference. FF 4. This is accomplished with the help of the coordinator's computer terminal which displays names and telephone numbers of all the parties involved in the

conference. FF 5. Thus, Beyda does teach the use of a graphical list to select subconference participants.

Third, Appellant argues that Beyda does not teach presenting to a user a graphical list of the subset of users in the subconference when the subconference is in progress. App. Br. 15-16; Reply Br. 4. However, as discussed above, the coordinator of the combined conference call, i.e., the subconference, has a computer terminal display that lists the names and telephone numbers of all parties involved in the subconference. FF 5. We find this to be sufficient to meet the claim limitation.

Thus, Appellant's arguments have not persuaded us of error in the Examiner's finding that Beyda teaches presenting a list of main conference participants to one of the users in the main conference, using an interface to select a subconference participant, and presenting a list of subconference participants when the subconference is in progress as claimed in independent claims 51, 60, and 62. Accordingly, we sustain the Examiner's rejection of these claims.

Claims 37-41, 43-50, 61, and 63-65

Appellant's arguments have not persuaded us of error in the Examiner's rejection of claims 37-41, 43-50, 61, and 63-65. Claims 37-41 and 43-50 are dependent upon claim 35; claim 61 is dependent upon claim 60; and claims 63-65 are dependent upon claim 62. Appellant's arguments present the same issues discussed with respect to claims 35, 60, and 62. Therefore, we sustain the Examiner's rejection of claims 37-41, 43-50, 61, and 63-65 for the reasons discussed *supra* with respect to claims 35, 60, and 62.

Claim 36

Appellant's argument has not persuaded us that the Examiner erred in rejecting claim 36. Claim 36 recites "wherein those users in the subconference are entirely isolated from participation in the main conference during the subsistence of the subconference." Appellant contends that Beyda does not teach this claim limitation because Beyda discloses a situation wherein participants can monitor the voice data of the main conference. App. Br. 16. However, Beyda clearly indicates that the purpose of allowing participants in a subconference to monitor the main conference is to overcome a deficiency found in the prior art. FF 7. Beyda discloses that it was known that parties to subconference calls were disconnected from the main conference call in order to establish a subconference call. FF 6. This indicates that participants to a subconference call were indeed completely isolated from the main conference call. Thus, we sustain the Examiner's rejection of claim 36.

Claims 42 and 58

Appellant's argument has persuaded us of error in the Examiner's rejection of claims 42 and 58. Claim 42 recites "wherein the users in the main conference are presented with said subconference list during the subsistence of the subconference." Claim 58 recites a similar limitation. Appellant argues that Beyda does not present a list of the subconference participants to the main conference participants. App. Br. 16. We agree with Appellant.

Beyda discloses providing a list of participants to the coordinator of each conference call. FF 5. In addition, when a party is dropped from a call, other coordinators are able to detect that participants are dropped. FF 6.

However, there is no evidence to suggest, nor has the Examiner cited to particular passages, that Beyda teaches providing a list of subconference participants to main conference participants. Therefore, we will not sustain the Examiner's rejection of claims 42 and 58.

Rejection of claims 52-55, 57, and 59 under 35 U.S.C. § 103(a) as being unpatentable over Beyda in view of Hamilton

Claims 52-55, 57, and 59

Appellant's arguments have not persuaded us of error in the Examiner's rejection of claims 52-55, 57, and 59. Claims 52-55, 57, and 59 are dependent upon claim 51, whose rejection we affirm *supra*. Therefore, we sustain the Examiner's rejection of claims 52-55, 57, and 59 for the reasons discussed *supra* with respect to claim 51.

Rejection of claim 56 under 35 U.S.C. § 103(a) as being unpatentable over Beyda in view of Hamilton and Mier

Claim 56

Appellant's arguments have not persuaded us of error in the Examiner's rejection of claim 56. Claim 56 is dependent upon claim 51. Appellant's arguments present the same issues discussed with respect to claim 51. Therefore, we sustain the Examiner's rejection of claim 56 for the reasons discussed *supra* with respect to claim 51.

CONCLUSIONS OF LAW

Appellant has not shown that the Examiner erred in finding that Beyda teaches presenting a list of main conference participants to one of the users in the main conference.

Appellant has not shown that the Examiner erred in finding that Beyda teaches using an interface to select a subconference participant.

Appellant has not shown that the Examiner erred in finding that Beyda teaches presenting a list of subconference participants when the subconference is in progress.

Appellant has shown that the Examiner erred in finding that Beyda teaches providing a subconference list to the users in the main conference during the subsistence of the subconference.

SUMMARY

The Examiner's rejection of claims 35-41, 43-57, and 59-65 is affirmed.

The Examiner's rejection of claims 42 and 58 is reversed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

<u>AFFIRMED-IN-PART</u>

ELD

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